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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,441	02/27/2004	Roberto Cavazzuti	05725.0795-02	1299
22852	7590	07/28/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,441

Applicant(s)

CAVAZZUTI ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 120-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 120-125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/7/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of IDS filed on 7/7/05. Claims 120-125 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

The references that were crossed-out have been considered, but it will not be listed for printing.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 120-125 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/618,066 which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.
2. See the paragraph bridging pages 2-3 for eyelashes, pages 4-5 for ingredient (i), see pages 10-13 for the polymer and see page 13, lines 5-15 for the species claimed as the polymer, see page 19, lines 3-18 for volatile which is isododecane at lines 12 and 18, see page 20 lines 10-14 for neutralizing agents, water, preserving agents, see pages 22-24 for coloring agents, see page 24 for packaging article. The disclosure of the co-pending application direct to those skilled in the art to the claimed compositions without any need for picking, choosing, and combining various disclosures are directly related to each other, by the teaching of the cited co-pending application.

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This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

3. Claims 120-125 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/685,577 which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

4. See the paragraph bridging pages 2-3 for eyelashes, pages 4-5 for ingredient (i), see pages 10-13 for the polymer and see page 13, lines 13-20 for the species claimed as the polymer, see page 19, lines 4-21 for volatile which is isododecane at lines 13 and 20, see pages 22-24 for coloring agent, see page 20, lines 3-15 for neutralizing agents, water, preserving agents, see page 24 for packaging article. The disclosure of the co-pending application direct to those skilled in the art to the claimed compositions without any need for picking, choosing, and combining various disclosures are directly related to each other, by the teaching of the cited co-pending application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Response to Arguments

5. Applicant's arguments filed 7/7/05 have been fully considered but they are not persuasive.

6. Applicants provide chart which explains the location of the claimed elements in both the applicants and argue that the ingredients which are recited in the composition are distributed randomly through out '066 and '577 applications as optional ingredients or as one of laundry list of possible compounds and as such extensive picking and choosing would be required to for one of ordinary skill in the art to have arrived at the presently claimed invention.

The arguments are with respect to the chart at pages 11-12. Applicant's attention is drawn to chart at pages 11-12 with respect to wax where applicants argue that the co-pending applications disclose the composition as being wax free.

In response to this the co-pending applications at page 3, lines 14-16 and page 4, lines 2-5 discuss the composition in the form of stick, like lipstick where in the composition is wax free. Note that the description of wax starts at pages 4-5 and pages 5-6 of '066 and '577 respectively.

Applicants argue that isododecane is one of the oils that can be useful for the liquid phase and the list spans almost two pages.

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In response to this, applicant's attention is drawn to page 20 of '066 and '577 where the specification clearly teaches that the structuring polymer of formula I can be combined with apolar oils and are chosen from pearl oil, isododecane and squalene. Therefore recitation of isododecane among three oils is not a laundry list.

Applicants argue that water and preservative are optional in both the applications.

In response to this, the same ingredients claimed in the instant application are also optional. There is no example in the instant application, which is drawn exclusively to Mascara compositions and the same is true for the co-pending applications. In conclusion, **the disclosure of the co-pending application direct to those skilled in the art to the claimed compositions without any need for picking, or choosing, and combining various disclosures are directly related to each other, by the teaching of the cited co-pending application.**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

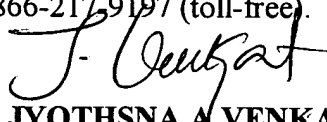
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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